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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,738	09/17/2001	Hans Konrad Schackert	012627-025	8967

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EXAMINER

WHISENANT, ETHAN C

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 11/14/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/936,738

**Applicant(s)**

SCHACKERT ET AL.

**Examiner**

Ethan Whisenant, Ph.D.

**Art Unit**

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-52 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**ELECTION/RESTRICTION**

- 1. Claim(s) 1-52** is/are pending in the application.

**LACK OF UNITY**

- 2.** Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

- I. Claim(s) 1-18, and 27-31**, drawn to a method of identifying organisms by comparative genetic analysis, classified in Class 435, subclass 6.
- II. Claim(s) 19**, drawn to a composition comprising oligonucleotide primers comprising SEQ ID Nos: 22,23, 24, and 25 classified in at least Class 536, subclass 24.3.
- III. Claim(s) 20**, drawn to a composition comprising oligonucleotide primers comprising SEQ ID Nos: 26 and 27 classified in at least Class 536, subclass 24.3.
- IV. Claim(s) 21**, drawn to a composition comprising oligonucleotide primers comprising SEQ ID Nos: 28, 29 and 30 classified in at least Class 536, subclass 24.3.
- V. Claim(s) 22**, drawn to a composition comprising oligonucleotide primers comprising SEQ ID Nos: 15 and 30 classified in at least Class 536, subclass 24.3.
- VI. Claim(s) 23**, drawn to a composition comprising oligonucleotide primers comprising SEQ ID Nos: 31 and 32 classified in at least Class 536, subclass 24.3.
- VII. Claim(s) 24**, drawn to a composition comprising oligonucleotide primers comprising SEQ ID Nos: 33 and 34 classified in at least Class 536, subclass 24.3.
- VIII. Claim(s) 25**, drawn to a composition comprising oligonucleotide primers comprising SEQ ID Nos: 35 and 36 classified in at least Class 536, subclass 24.3.

**IX. Claim(s) 26**, drawn to a composition comprising oligonucleotide primers comprising SEQ ID Nos: 37 and 38 classified in at least Class 536, subclass 24.3.

**X. Claim(s) 32-37**, drawn to a method of distinguishing the DNA of various species, classified in Class 435, subclass 6.

**XI. Claim 38**, drawn to Lightcycler hybridization probes for exon 5, classified in at least Class 536, subclass 23.1.

**XII. Claim 39**, drawn to Lightcycler hybridization probes for exon 6, classified in at least Class 536, subclass 23.1.

**XIII. Claim 40**, drawn to Lightcycler hybridization probes for exon 7, classified in at least Class 536, subclass 23.1.

**XIV. Claim 41**, drawn to Lightcycler hybridization probes for exon 8, classified in at least Class 536, subclass 23.1.

**XV. Claim 42**, drawn to Lightcycler hybridization probes for exon 9, classified in at least Class 536, subclass 23.1.

**XVI. Claim 43**, drawn to a composition comprising the hybridization probe pair A1/A2 specific to PTEN pseudogene of pigs, classified in at least Class 536, subclass 24.3.

**XVII. Claim 44**, drawn to a composition comprising the hybridization probe pair B1/B2 specific to PTEN pseudogene of man, classified in at least Class 536, subclass 24.3.

**XVIII. Claim 45**, drawn to a composition comprising the hybridization probe pair C1/C2 (i.e. B2) wherein C2 is specific to the PTEN pseudogene of man and C1 is specific to PTEN homologue of pig, classified in at least Class 536, subclass 24.3.

**XIX. Claim 46-47**, drawn to DNA sequences and /or fragment of homologues of the PTEN/MMAC1 gene and /or of homologues of the PTEN/MMAC1 pseudogene which code for proteins, classified in at least Class 536, subclass 24.3.

**XX. Claim 48-49**, drawn to a composition (i.e. a kit) comprising at least three components,

1) one or more vessels comprising PCR and/or sequencing oligos which bind to highly conserved genes; 2) vessels comprising further common reagents for DNA amplification and/or DNA analysis; 3) a vessel comprising a control DNA which is suited for testing.

**XXI. Claim 50**, drawn to a composition (i.e. a kit) comprising at least three components, 1) a vessel having an oligonucleotide pair wherein one oligo of said an oligonucleotide pair comprises SEQ ID NO: 8 and the second oligo comprises SEQ ID NO: 12; 2) two vessels, one comprising an oligo comprising SEQ ID NO: 53 and the second comprising an oligo comprising SEQ ID NO: 54; 3) a vessel comprising a control DNA which is suited for testing.

**XXII. Claim 51-52**, drawn to a composition (i.e. a kit) comprising at least three components, 1) a vessel having an oligonucleotide pair wherein one oligo of said an oligonucleotide pair comprises SEQ ID NO: 8 and the second oligo comprises SEQ ID NO: 12; 2) two vessels, one comprising an oligo comprising SEQ ID NO: 53 and the second comprising an oligo comprising SEQ ID NO: 54; 3) a vessel comprising a control DNA which is suited for testing, classified in Class 435, subclass 6 and /or Class 536, subclass 24.3.

**3.** The inventions listed as Groups I-XXII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature(s).


The claims as drawn are related to each other because they relate to a method of identifying organisms by comparative genetic analysis. However, since this method (i.e. Claim 1), as claimed, was known - see, for example, Jensen et al [US 5,753,467 (MAY 1998)] and/or Rogan [US 5,849,492 (DEC 1998)] - the claims are no longer linked by a special technical feature, because, by definition, the special technical feature must distinguish over the prior art. Without the special technical feature the claims lack unity.

**4..** Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

**5.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (703) 308-6567. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated

attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

The fax number for this Examiner is (703) 746-8465. Before faxing any papers please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989). Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0196.

  
ETHAN C. WHISENANT  
PRIMARY EXAMINER